



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/147,770	04/28/99	DEL SOLDATO	P 8907-9002

HM22/0620
NIKAIDO MARMELESTEIN MURRAY & ORAM
METROPOLITAN SQUARE
655 FIFTEENTH STREET NW
SUITE 330 G STREET LOBBY
WASHINGTON DC 20005-5701

EXAMINER	
MOEZIE, M	
ART UNIT	PAPER NUMBER

1617
DATE MAILED: 06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/147,770

Applicant(s)
Del Soldato et al.

Examiner
M. MOEZIE

Group Art Unit
1617



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-6 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-6 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1617

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, drawn to compounds, a use (or method) and a composition containing the same, for the treatment of urinary incontinence .

Group II, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of bronchitis.

Group III, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of asthma.

Group IV, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of early delivery.

Group V, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of pre-eclampsia.

Group VI, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of restenosis.

Art Unit: 1617

Group VII, claim(s) 6 (in part), drawn to a use (or method) for certain compounds in the treatment of gastrointestinal tumors.

The inventions listed as Groups I- VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: under 37 CFR 1.475© and (d), when multiple products or uses are claimed, the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto are considered the main invention. Unity of invention is not seen to be present with respect to claims drawn to additional uses for compounds herein. The uses claimed herein are seen to represent diverse areas of medical and/or pharmaceutical technology. Thus, the use of compounds herein to treat urinary incontinence, and the compounds and compositions useful therein, are considered to be the main invention, and each succeeding use for compounds herein is considered to be an additional invention.

Election of Species

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

compounds of the formula A-X₁-NO₂ herein.

Art Unit: 1617

Applicant is required, in reply to this action, to elect a single species (a single compound) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1-6.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The claimed inventions employ chemical compounds varying so widely in structure as to lack any common central core. Therefore, the search for all compounds herein is considered an undue burden.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

Art Unit: 1617

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Because the restriction requirement above is complex, a telephone call to applicant's agent to request an oral election was not made. See MPEP Sec. 812.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Moezie whose telephone number is (703) 308-4612. The examiner can normally be reached on Tuesday to Friday from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Moezie., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


MINNA MOEZIE
PRIMARY EXAMINER

MOEZIE:mm

June 18, 2000